

REMARKS

The present application was filed on September 23, 2003, with an effective filing date of December 20, 2002. Claims 1-22 remain pending, including independent claims 1, 21 and 22.

Claims 1-22 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2003/0065749 (hereinafter “Gailey”).

Applicants initially note that MPEP §2131 specifies that a given claim is anticipated “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the “identical invention . . . in as complete detail as is contained in the . . . claim,” citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Gailey was filed on October 3, 2002 and claims priority to U.S. Provisional Application Serial No. 60/326,826, filed on October 3, 2001. MPEP §2136.03(III) specifies that the 35 U.S.C. §102(e) critical reference date “is the filing date of the provisional application with certain exceptions *if* the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.” (emphasis in original)

In arguing that Gailey discloses the limitation of claim 1 directed to generating push content in a server responsive to information received in the server from an enterprise application, the Examiner relies on the arrangement shown in FIG. 1 of Gailey, which includes databases 34 stored on company servers 32 and service authorizer application 42 executed on service authorization server 40. Applicants respectfully submit that this arrangement does not appear to be mentioned by, much less adequately supported by, the provisional application to which Gailey claims priority.

Likewise, in arguing that Gailey discloses the limitation of claim 1 directed to receiving in the server from the mobile client device, responsive to the push content, a request for additional information identifiable at least in part by the push content, the Examiner relies on paragraphs [0039]-[0042] of Gailey. The subject matter disclosed in these paragraphs does not appear to be present in the provisional application to which Gailey claims priority.

Thus, because the provisional application fails to properly support the subject matter relied upon in compliance with 35 U.S.C. §112, first paragraph, the §102(e) critical reference date is the filing date of Gailey, October 3, 2002.

Applicants submit herewith a declaration of prior invention in accordance with 37 C.F.R. §1.131. The declaration is signed by each of the inventors named on the present application. The declaration and the exhibit attached thereto evidence the conception and actual reduction to practice of the claimed invention at least as early as April 19, 2002, and thus prior to the October 3, 2002 filing date of the Gailey reference. Applicants believe that the claims of the Gailey reference and the claims of the present application are neither directed to the same invention nor are obvious variants of one another. Applicants are therefore entitled to overcome the present §102(e) rejection using a declaration under 37 C.F.R. §1.131, in accordance with MPEP §§706.02(b) and 715.

Independent claims 21 and 22 contain limitations similar to that of claim 1 and are thus believed allowable for reasons similar to those identified above with regard to claim 1.

Dependent claims 2-20 are believed allowable at least because of their dependency from independent claim 1. One or more of these dependent claims are also believed to define separately-patentable subject matter over the cited art.

For example, claim 19 discloses a limitation wherein the push content is generated in the form of a service indication (SI) including at least one notification message and at least one corresponding URI. Applicants respectfully submit that the present rejection of claim 19 is both substantively and procedurally deficient.

By failing to indicate the portion of Gailey relied upon in formulating the rejection of claim 19, the Examiner has failed to comply with 37 C.F.R. §1.104(c)(2) (“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.”)

Moreover, Gailey fails to teach or suggest the limitation wherein the push content is generated in the form of a service indication (SI), much less the specific arrangement recited in claim

19. It should be further noted that Gailey, at [0044], discloses a technique wherein a notification message is sent via a text message and a URL is included in a separate e-mail message.

In view of the above, Applicants believe that claims 1-22 are in condition for allowance, and respectfully request withdrawal of the present §102(e) rejection.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph B. Ryan", with a stylized flourish at the end.

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